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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,053	05/28/2007	Mordechai Frisch	P-6166-US	7967
49443 7590 06/06/2011 Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036				
EXAMINER SMITH, PHILIP ROBERT				
ART UNIT		PAPER NUMBER		
3779				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@pczlaw.com
Arch-USPTO@pczlaw.com

Office Action Summary

Application No.

10/585,053

Applicant(s)

FRISCH ET AL.

Examiner

PHILIP SMITH

Art Unit

3779

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 9, 13, 17-19, 21, 22, 25, 30-32, 34 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 9, 17-19, 21, 22, 25, 30, 38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 13, 31, 32, 34 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 6/30/06
- 4) ☐ Interview Summary (PTO-813)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election of Species According to the Specification

- [01] This application is directed to the following patentably distinct species of fastener 202:
- [01a] a heat sensitive filament
 - [01b] a magnet
 - [01c] a degradable filament
- [02] The species are independent or distinct because they
- [02a] do not overlap in scope. See MPEP §806.04(b).
 - [02b] are mutually exclusive. See MPEP §806.04(f).
 - [02c] In addition, these species are not obvious variants of each other based on the current record.
- [03] Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.
- [04] There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply:
- [04a] the species or groupings of patentably indistinct species have acquired a separate status in the art in view of their different classification.
 - [04b] the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter.

- [04c] the species or groupings of patentably indistinct species require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).

Restriction

- [05] Restriction to one of the following inventions is required under 35 U.S.C. 121:

[05a] Claim(s) 1-4,6,9,13,31-32,34,37 drawn to an apparatus and system.

[05b] Claim(s) 38,17-19,21-22,25,30,39, drawn to a method.

- [06] The inventions are distinct because of the following reason:

[06a] Inventions [01a] and [01b] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, [01a] can be used without the step of activating a component in the first part.

- [07] Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply:

[07a] the inventions have acquired a separate status in the art in view of their different classification.

[07b] the inventions have acquired a separate status in the art due to their recognized divergent subject matter.

[07c] the inventions require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).

Telephonic Election

[08] Mr. Morey Wildes elected without traverse to prosecute the invention of [01c], a degradable filament or glue, and [05a], an apparatus and system. The elected embodiment and group are drawn to claims 1-4,6,13,31-32,34,37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9,17-19,21-22,25,30,38-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

Claim Rejections - 35 USC § 102

[09] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

States and was published under Article 21(2) of such treaty in the English language.

- [10] Claims 1-4,6,13,31-32,34,37 are rejected under 35 U.S.C. 102(a) as being anticipated by Lewkowicz (2003/0018280).
- [11] With regard to claim 1: Lewkowicz discloses an in-vivo sensing device comprising:
- [11a] a first part having a first specific gravity ("sensor system 32" [0028]); and
 - [11b] a second part having a second specific gravity ("buoy 34" [0028]),
 - [11c] wherein the first part and the second part are (inherently) detachable.
- [12] With regard to claim 2: the first specific gravity is greater than the second specific gravity.
- [13] With regard to claim 3: the second specific gravity is less than the specific gravity of a bodily fluid within a body lumen ("filled with a substance lighter than the body lumen liquid" [0027]).
- [14] With regard to claim 4: Lewkowicz discloses an imager and an illumination source ([0022]).
- [15] With regard to claim 6: Lewkowicz discloses a filament to temporarily attach the first part to the second part ("flexible sleeve 33" [0028]).
- [16] With regard to claim 13: the first part is (inherently) configured to detach in-vivo.
- [17] With regard to claim 31: Lewkowicz discloses a system for in-vivo sensing comprising: an in-vivo sensing device comprising:
- [17a] a first part having a first specific gravity ("32" as noted above);
 - [17b] a second part having a second specific gravity ("34" as noted above),
 - [17c] wherein the first specific gravity is different from the second specific gravity and the first part and the second part are attached by a (inherently) releasable fastener ("33" as noted above); and
 - [17d] an external receiver to receive wireless signals from the in-vivo device ([0017]).

- [18] With regard to claim 32: Lewkowicz discloses an in-vivo imager.
- [19] With regard to claim 34: an external transmitter for transmitting signals to the in-vivo device ([0017]).
- [20] With regard to claim 37: Lewkowicz discloses a display to display sensed data from an in-vivo sensing device ("view the colon" [0003]).

Conclusion

- [21] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - [21a] Gilreath 2006/0020171 discloses a "multi-piece unit 32" but it is not clear how or why the two pieces are connected or disconnected.
 - [21b] Iddan 2006/0004255 discloses a floating capsule device.
 - [21c] Glukhovskiy 2003/0120130 discloses a degradable filament that connects a capsule device to an insertion tube.
 - [21d] Uchiyama 2004/0111011 discloses a capsule with a drug attachment portion that is degradably connected.
 - [21e] Yokoi 2003/0023150 discloses two capsules connected by a tether.
 - [21f] Gross 5318557 discloses a two part capsule, one part of which degrades after releasing medicine (Figures 9-10).
 - [21g] Von Alten 6929636 discloses a 'fusible link' that triggers a splitting of the capsule.
- [22] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Sweet, can be reached on (571) 272 4761. Information regarding the status of an application may

Art Unit: 3779

be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip R Smith/
Primary Examiner, Art Unit 3779